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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,737	04/14/2004	John T. Forbis	T4890.B.CON.DIV2	6691

20449 7590 12/16/2004

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EXAMINER

FERGUSON, MICHAEL P

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/824,737

**Applicant(s)**

FORBIS, JOHN T.

**Examiner**

Michael P. Ferguson

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 37-42 and 68-81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-42 and 68-81 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 04/14/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. Claims 38, 68 and 76 are objected to because of the following informalities:

Claim 38 (line 2) recites " "L" shape". It should recite --L-shape--.

Claim 68 (line 8) recites " "L" shape". It should recite --L-shape--.

Claim 76 (line 2) recites " "L" shape". It should recite --L-shape--.

For the purpose of examining the application, it is assumed that appropriate correction has been made.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 37-39, 41, 68, 69, 71-73 and 75-77 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsai (US 5,695,174).

As to claim 37, Tsai discloses a retention clip **60** for receiving a catch **73** to attach a fence rail **50** to a support structure **70**, the retention clip comprising:

a first portion comprising a wall **62**, the wall having an aperture formed therein to define opposing resilient prongs **620**, the opposing resilient prongs each having a tooth formed thereon for engaging the catch;

a second portion **61**, the second portion having means (opening receiving fastener **610**) for attaching the retention clip to the fence rail;

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wherein the retention clip is configured to receive the catch between the opposing resilient prongs to attach the fence rail to the support structure (Figures 3 and 4).

As to claim 38, Tsai discloses a retention clip **60** wherein the first portion **62** and the second portion **61** form a substantial L-shape (Figure 3).

As to claim 39, Tsai discloses a retention clip **60** wherein the means for attaching the retention clip to the fence rail **50** comprises an opening for receiving a fastener **610** (Figure 3).

As to claim 41, Tsai discloses a retention clip **60** wherein the second portion **61** comprises a recessed area surrounding the opening for receiving the fastener **610** (Figure 3).

As to claim 68, Tsai discloses a clip **60** for receiving a catch **73** to attach a fence rail **50** to a support structure **70**, the clip comprising:

a first portion comprising a wall **62**, the wall having an aperture formed therein to define opposing prongs **620**;

a second portion **61**, the second portion having an opening for receiving a fastener **610** for attaching the clip to the fence rail;

wherein the first portion and the second portion form a substantial L-shape, and wherein the clip is configured to receive the catch between the opposing prongs to attach the fence rail to the support structure (Figures 3 and 4).

As to claim 69, Tsai discloses a clip **60** wherein the opposing prongs **620** are resilient.

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As to claim 71, Tsai discloses a clip **60** wherein the second portion **61** comprises a recessed area surrounding the opening for receiving the fastener **610** (Figure 3).

As to claim 72, Tsai discloses a clip **60** wherein the prongs **620** comprise two prongs (Figure 3).

As to claim 73, Tsai discloses a clip **60** wherein each of the prongs **620** comprise a tooth for engaging the catch **73** (Figure 3).

As to claim 75, Tsai discloses a clip **60** for receiving a catch **73** to attach a fence rail **50** to a support structure **70**, the clip comprising:

a first portion comprising a wall **62**, the wall having an aperture formed therein to define opposing prongs **620**;

a second portion **61**, the second portion having an opening for receiving a fastener **610** for attaching the clip to the fence rail;

wherein the second portion comprises a recessed area surrounding the opening for receiving the fastener, and

wherein the clip is configured to receive the catch between the opposing prongs to attach the fence rail to the support structure (Figures 3 and 4).

As to claim 76, Tsai discloses a retention clip **60** wherein the first portion **62** and the second portion **61** form a substantial L-shape (Figure 3).

As to claim 77, Tsai discloses a clip **60** wherein the opposing prongs **620** are resilient.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 42 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai.

As to claim 42, Tsai fails to disclose a retention clip wherein the tooth comprises two teeth.

Applicant is reminded that duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the retention clip disclosed by Tsai to comprise prongs each having two teeth as such practice is a design consideration within the skill of the art.

As to claim 74, Tsai fails to disclose a clip wherein each of the prongs comprise two teeth.

Applicant is reminded that duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the retention clip disclosed by

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Tsai to comprise prongs each having two teeth as such practice is a design consideration within the skill of the art.

6. Claims 40, 70 and 78-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai in view of Helterbrand et al. (US 3,942,763).

As to claim 40, Tsai fails to disclose a retention clip wherein the opening is substantially oval shaped.

Helterbrand et al. teach a retention clip **14** wherein an opening **42** is substantially oval shaped; the oval shape of the slot enabling the retention clip to be slid relative to an attached fence member, allowing the alignment between an attached rail and a structural member to be adjusted (Figure 2, column 5 lines 38-43). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify a retention clip as disclosed by Tsai to have an oval shaped opening as taught by Helterbrand et al. in order to enable the retention clip to slid relative to the fence rail to adjust the alignment between the fence rail and the structural member.

As to claim 70, Tsai fails to disclose a retention clip wherein the opening is substantially oval shaped.

Helterbrand et al. teach a retention clip **14** wherein an opening **42** is substantially oval shaped; the oval shape of the slot enabling the retention clip to be slid relative to an attached fence member, allowing the alignment between an attached rail and a structural member to be adjusted (Figure 2, column 5 lines 38-43). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify a retention clip as disclosed by Tsai to have an oval shaped opening as

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taught by Helterbrand et al. in order to enable the retention clip to slid relative to the fence rail to adjust the alignment between the fence rail and the structural member.

As to claim 78, Tsai fails to disclose a retention clip wherein the opening is substantially oval shaped.

Helterbrand et al. teach a retention clip **14** wherein an opening **42** is substantially oval shaped; the oval shape of the slot enabling the retention clip to be slid relative to an attached fence member, allowing the alignment between an attached rail and a structural member to be adjusted (Figure 2, column 5 lines 38-43). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify a retention clip as disclosed by Tsai to have an oval shaped opening as taught by Helterbrand et al. in order to enable the retention clip to slid relative to the fence rail to adjust the alignment between the fence rail and the structural member.

As to claim 79, Tsai discloses a clip **60** wherein the prongs **620** comprise two prongs (Figure 3).

As to claim 80, Tsai discloses a clip **60** wherein each of the prongs **620** comprise a tooth for engaging the catch **73** (Figure 3).

As to claim 81, Tsai fails to discloses a clip wherein each of the prongs comprise two teeth.

Applicant is reminded that duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the retention clip disclosed by



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Tsai to comprise prongs each having two teeth as such practice is a design consideration within the skill of the art.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure. The following patents show the state of the art with respect to retention clips:

Baker (US 5,649,688), Meis et al. (US 6,499,725), West (US 6,682,056) and Furr et al. (GB 2 224 048) are cited for pertaining to retention clips comprising opposing prongs and an opening for receiving a fastener.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Ferguson whose telephone number is (703)308-8591. The examiner can normally be reached on M-F (7:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703)308-2686. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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12/08/04



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